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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85914469
Applicant	Graystone Consulting Associates, Inc.
Applied for Mark	VALUE SHOPPER
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
Graystone Consulting Associates, Inc.	:	
	:	
	:	
Serial Nos.:	:	Examining Attorney: Laura Golden
85/914457, 85/914469,	:	
and 85/914478	:	
	:	
Filed:	:	
April 1, 2015	:	
	:	
Marks:	:	
QUALITY SHOPPER,	:	
VALUE SHOPPER	:	
and PRICE SENSITIVE	:	
SHOPPER	:	
	:	

BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant Graystone Consulting Associates, Inc. (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq. of The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of its appeal of the Office’s refusal to register the instant trademarks on the grounds that the specimens are unacceptable.

II. STATEMENT OF THE CASE

Quality Shopper

The original application for the mark QUALITY SHOPPER was filed by Applicant April 25, 2013 in connection with “business consultancy services” and received Serial No. 85914457. In an office action dated August 22, 2013, the Examining Attorney identified a disclaimer requirement, a matching requirement, and a need for a substitute specimen showing the use of the mark with the listed services.

Applicant responded on February 21, 2014 by submitting new specimen. On March 13, 2014, the Examining Attorney withdrew the disclaimer requirement and the matching requirement, while making the specimen issue final. Applicant responded on July 9, 2014 with a substitute specimen and request for reconsideration. The Examining Attorney rejected this specimen and request for reconsideration on July 9, 2014. The Examining Attorney rejected the second substitute specimen on July 24, 2014. On August 29, 2014 Applicant submitted a third substitute specimen (hereafter “Substitute Specimen”). Applicant appealed the Examining Attorney’s final refusal to the Board on September 15, 2014, requesting remand on November 14, 2014, which was granted. The Examining Attorney denied reconsideration of the matter in a letter dated December 2, 2014, maintaining the previous refusals and making the matter ripe for the instant appeal.

Value Shopper

The original application for the mark VALUE SHOPPER was filed by Applicant on April 25, 2013 and received Serial No.85914469. In an office action dated August 22, 2013, the Examining Attorney identified a matching requirement and a substitute specimen requirement, as well as issuing a 2(e)(1) refusal of the mark as being merely descriptive.

Applicant responded on February 21, 2014 by submitting a new specimen. On March 13, 2014 the Examining Attorney withdrew the matching requirement, while making final the specimen issue and the merely descriptive refusal.

Applicant responded on July 9, 2014 with a substitute second specimen and request for reconsideration. The Examining Attorney rejected this second specimen and request for reconsideration on July 24, 2014. On August 28, 2014, Applicant submitted a third substitute specimen (hereafter “substitute specimen”) and request for reconsideration after a final office action and amended the application from registration on the Principal to the Supplemental Register.

Ultimately, the Applicant appealed the Examining Attorney’s decision to the Board on September 15, 2014 requesting remand on November 14, 2014 which was granted by the Board on November 19, 2014. Ultimately, the Examining Attorney denied reconsideration of the matter in a letter dated December 2, 2014, maintaining the previous refusals and making the matter ripe for the instant appeal.

Price Sensitive Shopper

The original application for the mark PRICE SENSITIVE SHOPPER was filed by Applicant on April 25, 2013 and received Serial No.85914478. In an office action dated August 22, 2013,

the Examining Attorney identified a matching requirement, and a substitute specimen requirement, as well as issuing a 2(e)(1) refusal of the mark as being merely descriptive. Applicant responded on February 21, 2014 by submitting a substitute specimen.

On March 13, 2013 the Examining Attorney withdrew the matching requirement, while making final the specimen issue and the merely descriptive refusal. Applicant responded on July 9, 2014 with a second substitute specimen and request for reconsideration. The Examining Attorney rejected this second specimen and request for reconsideration on July 24, 2014. On August 28, 2014, Applicant submitted a third substitute specimen (hereafter “Substitute Specimen”) and request for reconsideration after a final office action and amended the application from registration on the Principal to the Supplemental Register. Applicant appealed the Examining Attorney’s decision to the Board on September 15, 2014, requesting remand on November 14, 2014 which was granted by the Board on November 19, 2014. Ultimately, the Examining Attorney denied reconsideration of the matter in a letter dated December 2, 2014. The sole remaining issue on appeal is the specimen issue.

Consolidation of the Instant Appeals

Applicant filed a motion requesting consolidation of the instant files on February 2, 2015. The Board granted the motion for consolidation in part, and denied the motion, in part. The Board granted the motion for consolidation with respect to the applications for the marks QUALITY SHOPPER (Serial No. 85914457), VALUE SHOPPER (Serial No. 85914469), and PRICE SENSITIVE SHOPPER (Serial No. 85914478). The instant brief is thus filed to address the sole issue remaining unresolved in these files.

III. ARGUMENT

“An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a trademark with respect to the goods named in the application”. *In re Bose Corp.*, 546 F.2d 893, 897 (C.C.P.A. 1976). “Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify. Thus, it is essential for registration that words first become a trademark, i.e., any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.” 15 U.S.C.S. § 1127. *In re Bose Corp.*, 546 F.2d 893 (C.C.P.A. 1976).

An application for registration under §1(a) of the Trademark Act or an allegation of use in an application under §1(b) of the Act must include one specimen per class showing use in commerce of the applied-for mark on or in connection with the goods, or in the sale or **advertising of the services** (emphasis added.) 15 U.S.C. §§1051(a)(1), 1051(c) and 1051(d)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.76(b) and 2.88(b).

An advertisement is a sufficient specimen of use if there is a direct link between the term and the services advertised. *Peopleware Sys. v. Peopleware, Inc.*, 1985 TTAB LEXIS 84, 11-12 (Trademark Trial & App. Bd. May 31, 1985). The actual appearance of the mark in context is also relevant as a measure of how a consumer would perceive the mark. *In Re Safariland Hunting Corp.*, 24 USPQ2d 1380(TTAB 1992). An advertisement is sufficient evidence of the mark's use in commerce if a proposed mark is used in a way which would be perceived by

purchasers to identify the source of the goods or service. *In re C.R. Anthony Co.*, LEXIS 81, 3-5 (1987 TTAB). An advertising specimen is sufficient evidence of a proposed mark's use in commerce if it is "used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods." *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455 (TTAB 1998). Whether or not the mark is successful in this calculation is an entirely separate inquiry from the one at hand, which asks merely whether a potential purchaser would be capable of discerning the source of the goods as a result of the use of the mark in the specimen.

The examining attorney must review the specimen to determine whether the applied-for mark appears on the specimen, the specimen shows use for the specific goods/services identified, and the specimen otherwise shows the applied-for mark in "use in commerce." TMEP §§904, 904.07(a).

An application for registration under §1(a) of the Trademark Act or an allegation of use in an application under §1(b) of the Act must include one specimen per class showing use in commerce of the applied-for mark on or in connection with the goods, or in the sale or **advertising of the services** (emphasis added.) 15 U.S.C. §§1051(a)(1), 1051(c) and 1051(d)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.76(b) and 2.88(b). An advertisement is a sufficient specimen of use if there is a direct link between the term and the services advertised. *Peopleware Sys. v. Peopleware, Inc.*, LEXIS 84, 11-12 (TTAB 1985). "However, we may also consider other evidence bearing on the question of what impact applicant's use is likely to have on purchasers and potential purchasers. *In Re Safariland Hunting Corp.*, 24 USPQ2d 1380(TTAB 1992).

An advertisement is sufficient evidence of the mark's use in commerce if a proposed mark is used in a way which would be perceived by purchasers to identify the source of the

goods or service. *In re C.R. Anthony Co.*, LEXIS 81, 3-5 (TTAB1987). “To be a mark, the phrase must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods.” *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455 (TTAB 1998).

Whether or not the mark is successful in this calculation is an entirely separate inquiry from the one at hand, which asks merely whether a potential purchaser would be capable of discerning the source of the goods as a result of the use of the mark in the specimen.

The examining attorney must review the specimen to determine whether the applied-for mark appears on the specimen, the specimen shows use for the specific goods/services identified, and the specimen otherwise shows the applied-for mark in “use in commerce.” TMEP §§904, 904.07(a). Applicant’s applied-for marks **QUALITY SHOPPER**, **VALUE SHOPPER**, and **PRICE SENSITIVE SHOPPER** **do** appear on the specimens, both at the top of the flyers in bold letters, and in the description of the services in bold letters. The specimens **do** show the business training consultancy services identified in the following sentences of the training materials:

“With Graystone’s training, funeral professionals learn what type of shopper they are encountering. The **Price-Sensitive Shopper™** values the price paid over the value or quality of services provided. The **Value Shopper™** shops services based on the overall value provided for services rendered. The **Quality Shopper™** seeks quality services no matter the cost to receive such services. Using the Graystone concepts, paraphrasing and listening skills, funeral professionals can pin-point the type of shopper encountered and direct responses to either price, value or quality.”

Moreover, the specimens do show the applied-for mark in “use in commerce,” by displaying the mark on an advertisement for training in the acquisition of a specific skill which is available to purchaser of the Applicant’s services along with other aspects of the training program. In the instant case, the substitute specimen shows a flyer displaying the applied for

trademark at the top of the page, in bold letters. The paragraph beneath the trademark describes the services provided under the applied for trademark. The specimen is an advertisement for skills-acquisition training which is sold as part of the comprehensive method available for purchase from the Applicant. The service provided by the Applicant is the training and development of skills in the context of running a successful funeral services business. Individuals who are interested in becoming funeral directors or in starting a funeral services company may purchase training and training materials from the Applicant. The marks **QUALITY SHOPPER**, **VALUE SHOPPER**, and **PRICE SENSITIVE SHOPPER** are each components of the training method the Applicant sells to interested individuals. When an interested individual purchases services from the Applicant, the individual is also purchasing training in the skill of identifying how best to relate to various types of customers. Training in this skill, the identification of a customer's needs, and the companion skill of responding appropriately, is a key component of the service offered by the Applicant. As such, there is a direct link between the terms appearing in the advertisement and the services advertised, making the specimens sufficient for the purpose of demonstrating the use of the mark in commerce.

In view of the above arguments, Applicant believes that the proposed mark **QUALITY SHOPPER** is entitled to registration on the Principal Register insofar as the specimen does show a direct association between the applied-for mark and the identified services. Applicant further believes that the proposed marks **VALUE SHOPPER** and **PRICE SENSITIVE SHOPPER** are entitled to registration on the Supplemental Register insofar as the specimens show a direct association between the applied-for marks and the identified services.

Conclusion

WHEREFORE the Applicant Graystone Consulting Associates, Inc. by counsel, respectfully requests that the specimen refusals be reversed with respect to the mark QUALITY SHOPPER and the mark be allowed for registration. In addition, the Applicant Graystone Consulting Associates, Inc. by counsel, respectfully requests that the specimen refusals be reversed with respect to the marks VALUE SHOPPER and PRICE SENSITIVE SHOPPER and the marks be allowed for publication on the Supplemental Register.

Respectfully submitted,

/Matthew H. Swyers/

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